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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,967	10/19/2001	Hiromu Ueshima	100341-00017	7298
4372	7590	04/26/2006	EXAMINER	
ARENT FOX PLLC 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			MOSSER, ROBERT E	
			ART UNIT	PAPER NUMBER
			3712	

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,967

Applicant(s)

UESHIMA ET AL.

Examiner

Robert Mosser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION



In response to the communication filed March 10th, 2006.

This action is Non-Final.

Claims 10-22 are rejected.



Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 20th, 2006 has been entered.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **10-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (6,328,570) in view of Tokano (US 5,838,577).

Claim 10: Ng teaches a portable karaoke unit including a single removable memory cartridge, means for selecting a program from a plurality of at least one karaoke programs and at least one game programs stored on the single removable memory cartridge (Col 3:37-45 & Claim 2). Ng further teaches the inclusion of a cartridge sensing means and the utilization of identifiers to enable/disable cartridge content use.

Specifically, Ng utilizes removable memory cartridge (135) capable of storing games programs and song related data including audio data, lyrics, timing information

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and graphical information (Col 3:37-45 & Claim 2). Ng teaches the use of a menu system interface for directing the desired functionality of the unit (Fig 1, 5, 10 & Col 3:24-34). This menu interface description has been interpreted as the means of selecting the karaoke program and the means of selecting the game program from a plurality of similar stored programs.

Ng teaches the determination of whether or not a cartridge is legal (620) however is arguably silent regarding the determination of whether the cartridge is attached and generating a warning message only if the cartridge is not attached. In a cartridge based media device Tokano teaches detecting and generating a warning message if and only if a cartridge (solid state memory device) is not attached to the main device indicating that the cartridge is not attached to the device (Tokano Figure 8, &10). It would have been obvious ^{to one of ordinary skill in the art at the time of invention} to have incorporated the warning message and memory device verification system and method of Tokano into the karaoke unit of Ng in order to inform the user that a cartridge is not connected to the device.

^{from SEP 11/06}
~~From~~ the preceding the following is understood.

I. Ng utilizes identifiers (held as equivalent to identification information) in order to determine compatibility.

II. In order to determine (determination) whether or not an identifier is appropriate (legal) the base must perform a comparison or analysis of the identifier stored.

This is resultant from the fact that the only processor shown (210) is located in the body of the device.

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III. Based on this determination an operation is either allowed to proceed or terminated.

IV. Tokano in combination with Ng provides for the generation of an error message when a cartridge is not attached to the system.

In view of the preceding points it is understood that the invention of Ng/Tokano would only allow the use of programs with corresponding identifiers to the based ("illegal programs" of Ng) would be implicitly require the analysis of information/programs contained on said cartridge. Ng however does not explicitly state that each program has a corresponding assigned identifier or that an identifier is stored in the base rather than the cartridge. It would have been obvious to one of ordinary skill in the art to store an identifier in the base in order to allow the processing unit of the base to determine the correspondence between the intended media and the present media device to insure compatibility. It would have been obvious to one of ordinary skill in the art at the time of invention to associate the identifier with the programs of Ng rather than the memory cartridge to allow reuse of the memory cartridge with multiple media playing devices.

As amended the claims now provide for two separate devices including a gaming device and a karaoke device exclusive from one another. The prior art of Ng provides for a device with capability to execute karaoke programs and game programs stored on a singular game cartridge however is silent regarding the separation of the device into two separate and discrete devices. However as presented this feature represents

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merely the separation of a previously singular device into multiple singular devices. It therefore would have been obvious to one of ordinary skill in the art at the time of invention to have separated the gaming functionality and the karaoke functionality of the singular device of Ng into a singular gaming device and a singular karaoke device in order to reduce manufacturing cost (The section entitled Response to arguments below is incorporated herein)

Response to Arguments

Applicant's arguments filed 2/03/2005 have been fully considered but they are not persuasive.

I) Applicant argues the following claim language:

"determining whether the memory cartridge is attached to a main body of the karaoke apparatus;

determining whether the memory cartridge is attached to a main body of the gaming apparatus that is separate from the karaoke apparatus"

This argument is centered about the separation of a singular device into multiple device. However as both singular device are well known in the art such as the cartridge based karaoke device of Ng USP 5,648,628 (Not presently relied upon) or the well known cartridge gaming device Nintendo Entertainment System (Not presently relied upon) this feature falls under an obviousness type of rejection. Additionally, though not presently raised, the next logical issue to be raised is the cross compatibility of the claimed cartridge between the gaming device and karaoke device, however the device

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of NG (6,328,570) sets forth a cartridge capable of storing both types of data hence the separation of a the singular device and as the cartridge has not been modified the common cartridge is maintained with the split of the previous combined device into two devices. In addition to this, references including Weinstein USP 5,608,905 (Not presently relied upon) set forth the inclusion of multiple data types readable by multiple separate devices on a singular medium.

II) Applicant argues the equation of a Ng's determination of a legal cartridge is improperly correlated to the claimed warning signal message program based only on the absence of a cartridge (*Applicant's Remarks Pages 7-8*).

As presented the claim limitation of:

".. if and only if a memory cartridge is not attached to the main body of the karaoke apparatus, selecting a warning message program stored in the main body of the karaoke apparatus.", provides for a particular circumstance of when to load and execute a warning message yet does not exclude the incorporation of other messages per se. under this interpretation the invention of Ng/Tokano includes illegal messages and a "warning" message. As such the "Warning message" and "illegal information" are not held as equivalents under the present interpretation.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM


SCOTT JONES
PRIMARY EXAMINER